

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

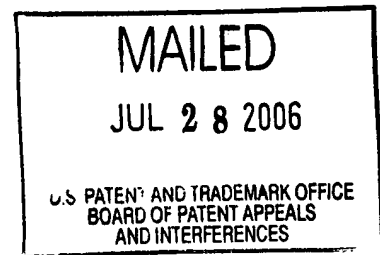
Ex parte BROR H. HANSON

Appeal No. 2005-2270
Application No. 09/954,899

ON BRIEF

Before PAK, TIMM, and FRANKLIN, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.



DECISION ON APPEAL

This appeal involves claims 11, 12, 15, and 16, the finally rejected claims. The only other pending claims, claims 13 and 14, have been allowed. Claims 1-10 have been canceled. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims are directed to a method for forming a mold-release coating system on a mold surface. Claim 11 is illustrative:

A method for forming a mold-release coating system on a mold surface, comprising:

providing a barrier coating of a substantially liquid wax material, wherein the wax material includes about 7 to about 10 weight percent solids;

applying the wax material onto the mold surface;

permitting wax material to substantially dry after application onto the mold surface;

providing a release powder; and

applying the release powder onto the barrier coating after the wax material has been permitted to substantially dry after application onto the mold surface.

The Examiner relies on the following evidence to support the rejections:

Urena	5,294,251	March 15, 1994
Hanson et al. (Hanson '495)	6,117,495	Sept. 12, 2000
Hanson et al. (Hanson '026)	6,291,026	Sept. 18, 2001 ¹

The rejections as presented by the Examiner are as follows:

1. Claims 11, 12, 15, and 16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hanson '495 in view of Urena.
2. Claims 11, 12, 15, and 16 are rejected under the judicially created doctrine of

¹ Prior art under 35 U.S.C. § 102(e). The effective filing date of Hanson '026 is April 30, 1997 or earlier.

obviousness-type double patenting as being unpatentable over claims 1-4, 6, 8, and 9 of Hanson '495 in view of Urena.

3. Claims 11, 12, 15, and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 8, and 12 of Hanson '026 in view of Urena.

We affirm substantially for the reasons presented by the Examiner and add the following primarily for emphasis.

OPINION

Obviousness over Hanson '495 in view of Urena

Appellant argues that Hanson '495 and Urena lack “providing a barrier coating of a substantially liquid wax material, wherein the wax material includes about 7 to about 10 weight percent solids, permitting wax material to substantially dry after application onto a mold surface, and applying the release powder into the barrier coating after the wax material has been permitted to substantially dry after application onto the mold surface.” (Brief, pp. 14 and 15). According to Appellant, in Hanson '495, “there is no 7 to about 10 weight percent solids in a substantially liquid wax material.” (Brief, p. 14). Further according to Appellant, in Urena, “the composition coating contains 10 to 15 parts by weight microcrystalline wax and not 7 to about 10 weight percent solids in a substantially liquid wax material.” (Brief, p. 15). Appellant also argues that there is “absolutely no teaching of a level of skill in the mold release art” of

performing the above quoted operations. On the above basis, Appellant argues “there is no suggestion or motivation in the art to combine Hanson et al. ‘495 and Urena ‘251 together.” (Brief, p. 16).

The problem with Appellant’s argument is that it views the statements within the references in isolation and without truly considering the teachings together with the knowledge of those of ordinary skill in the art. “[A] prior art reference must be considered together with the knowledge of one of ordinary skill in the pertinent art.” *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994)(citing *In re Samour*, 571 F.2d 559, 562, 197 USPQ 1, 3-4 (CCPA 1978)). Furthermore, “[A] reference must be considered not only for what it expressly teaches, but also for what it fairly suggests.” *In re Burckel*, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979)). “The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art.” *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

We agree with the Examiner that there is a reason or suggestion to use the wax coating composition of Urena as the solvent-based wax mold release composition of Hanson ‘495. In fact, Urena expressly suggests this use (Urena, col. 5, ll. 22-26). The evidence cited by the Examiner supports the Examiner’s finding of a reason to make the combination (Answer, pp. 6-7).

The evidence also supports the Examiner’s determination that it would have been obvious to one of ordinary skill in the art to have selected solids concentrations within the claimed range

(Answer, p. 7). For most applications, the wax is present in the amount of 5-15 wt.% (Urena, col. 4, ll. 34-35). The Examiner's finding that the wax content is equivalent to the solids content is reasonable in light of the disclosures within Urena, what was known in the art, and the lack of convincing contrary evidence provided by Appellant. The solids content range of Urena overlaps the claimed range. Also, Urena discloses specific examples of solvent-based wax compositions used as mold release coatings wherein the composition contains 10 wt.% wax, i.e., 10 wt. % solids (Table 1, Examples 5 and 7), an amount within the claimed range. Moreover, according to Urena, thicker coatings can be produced on the coated article by increasing the concentration of the wax (Urena, col. 4, ll. 48-50). Optimizing the solids content would have been within the capabilities of one of ordinary skill in the art.

At solids concentrations within the ranges of Urena, the wax material is "substantially liquid" as claimed because it is mostly solvent, contains small particles of wax dispersed in the solvent (Urena, col. 3, ll. 7-18), and is formulated for brushing, spraying, dipping, or flooding (Urena, col. 4, ll. 51-53).

With regard to the drying requirements of claim 11, the Examiner finds that the wax material would have been substantially dry at least by the second molding operation (Answer, pp. 7-8). We agree. In fact, even before the first molding operation, one of ordinary skill in the art would have allowed the wax to dry before application of the release powder. Hanson '495 describes using solvent-based wax and spraying this solvent-based wax onto the mold (Hanson '495, col. 5, ll. 53-59). There is nothing to indicate that the solvent-based wax referred to is anything other than the conventional-type discussed in the Background of the Invention.

According to the Background of the Invention, such solvent-based wax mold release agents “are applied to the interior surface of molds and allowed to dry.” (Hanson ‘495, col. 1, ll. 31-33).

Hanson ‘495 also describes electrostatically depositing the release powder on a base coat (Hanson ‘495, col. 5, ll. 61-64). The base coat is a built-up layer of solvent-based wax (Hanson ‘495, col. 5, ll. 56-59). In order to build layers, drying of the layers is required.

We conclude that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 11, 12, 15, and 16 that has not been sufficiently rebutted by Appellant.

Obviousness-type Double Patenting

With regard to the double patenting rejections, Appellant argues that “the Examiner has failed to correct [sic] apply an obviousness-type double patenting rejection by comparing the invention to the claims, and only the claims, of the prior art references.” (Brief, p. 7). Based on a comparison of the claimed invention to claim 1 of Hanson ‘495 and ‘026, respectively, and to claim 7 of Urena, Appellant determines there is no basis for an obviousness-type double patenting rejection (Brief, pp. 6-7 and 8-9).

First, the Hanson references are not “prior art references” and this is why the disclosures therein cannot be used as prior art against Appellant’s claims. That does not mean, however, that the disclosure cannot be consulted at all. As stated in *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 621-22 (CCPA 1970):

In considering the question, the patent disclosure may not be used as prior art. *In re Boylan, supra*; *In re Aldrich*, 398 F.2d 855, 55 CCPA 1431 (1968). This does not mean that the disclosure may not be used at all. As pointed out above, in

certain instances it may be used as a dictionary to learn the meaning of terms in a claim. It may also be used as required to answer the second analysis question above[: Does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent?] We recognize that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim. A claim is a group of words defining only the boundary of the patent monopoly. It may not describe any physical thing and indeed may encompass physical things not yet dreamed of. How can it be obvious or not obvious to modify a legal boundary? The disclosure, however, sets forth at least one tangible embodiment within the claim, and it is less difficult and more meaningful to judge whether that thing has been modified in an obvious manner. It must be noted that this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. § 103, since only the disclosure of the invention claimed in the patent may be examined.

Not only can the written description of the patent specification be relied upon to determine the meaning of claim terms, it can also be used to determine what embodiments of the patented invention are encompassed within the patented claims for comparison to the embodiments encompassed by the rejected claims. Moreover, as pointed out by the Examiner, Urena is a prior art reference, its disclosure can be used as prior art in considering the question of whether the claims in the application merely define an obvious variation of the methods claimed in the Hanson patents (Answer, p. 9).

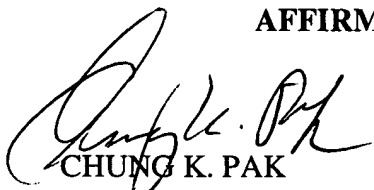
We conclude that the Examiner has established a prima facie case of obviousness-type double patenting which has not been sufficiently rebutted by Appellant.


CONCLUSION

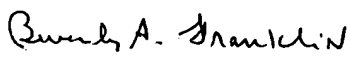
In summary, we affirm the decision of the Examiner wherein the Examiner rejected claims 11, 12, 15, and 16 under 35 U.S.C. § 103(a) and under the judicially created doctrine of obviousness-type double patenting.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(2004).

AFFIRMED


CHUNG K. PAK)
Administrative Patent Judge)


CATHERINE TIMM) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
INTERFERENCES)


BEVERLY A. FRANKLIN)
Administrative Patent Judge)

CT/TF

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BLISS, MCGLYNN & NOLAN, P.C.
SUITE 600
2075 WEST BIG BEAVER ROAD
TROY, MI 48084